

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HOLOGIC, INC. and CYTYC SURGICAL
PRODUCTS, LLC,

Plaintiffs and
Counterdefendants,

V.

MINERVA SURGICAL, INC.,

Defendant and
Counterclaimant.

C.A. No. 15-1031-JFB-SRF

JURY TRIAL DEMANDED

REDACTED PUBLIC VERSION

**DEFENDANT MINERVA SURGICAL, INC.’S OPPOSITION TO
PLAINTIFFS’ MOTION *IN LIMINE* NO. 4 TO PRECLUDE MINERVA FROM
ARGUING THAT THE PATENTS-IN-SUIT DO NOT ENABLE OR DESCRIBE
UNCLAIMED FEATURES OF THE ACCUSED PRODUCT**

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Dated: July 2, 2018

Hologic's motion should be denied as moot. It was filed before this Court entered its summary judgment opinion and order. D.I. 407; D.I. 408. That order granted summary judgment that assignor estoppel bars Minerva's written description and enablement invalidity defenses. Therefore at trial, Minerva will not present evidence or argument, such as opinion testimony of Dr. Robert Tucker ("Tucker"), that the asserted patents are not described or enabled. All of the testimony and argument Hologic identifies for exclusion is for Minerva's written description and enablement defenses. D.I. 292 Ex. 28 (Tucker's Expert Report); D.I. 292 Ex. 8 (portions of Tucker's deposition testimony); D.I. 278, 341 (portions of Minerva's summary judgment briefing). As relief, Hologic requests an order precluding Minerva "from arguing or presenting evidence at trial that the Patents-in-Suit do not *enable or describe* unclaimed features of the accused Minerva product." D.I. 395 at 3 (emphasis added). The Court's aforementioned summary judgment ruling moots Hologic's request.

Hologic's motion is confined to the aforementioned invalidity defenses. Also, Hologic does not seek to exclude all evidence related to the asserted patents or features of Minerva's product be excluded. It cannot because such evidence is relevant and highly probative to at least willfulness and damages—issues that remain for the jury to decide. D.I. 408 ¶10. As to willfulness, that inquiry is one of fact and "is determined from the totality of the circumstances." *ACCO Brands, Inc. v. ABA Locks Mfrs.*, 501 F.3d 1307, 1312 (Fed. Cir. 2007). Factors to consider in assessing willfulness include "whether the infringer deliberately copied the ideas or design of another" and "whether the infringer, when he knew of the other's patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed." *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 827 (Fed. Cir. 1992). Yet other factors to consider include "whether the infringer exercised care to respect the legal rights of the

patentee,” “whether the actions taken were reasonable,” “independent development by the infringer, and various aspects of the actual relationship between the patentee and the infringer.” *Nat’l Presto Indus. v. W. Bend Co.*, 76 F.3d 1185, 1192-93 (Fed. Cir. 1996). Minerva expects to provide testimony and evidence relevant to and highly probative of those factors, including its good faith belief that it did not infringe a valid patent, the bases therefore, Minerva’s lack of copying Hologic’s patents or products, the reasonableness of its conduct, and its independent development. Minerva will respond accordingly if and when Hologic objects to such evidence at trial.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Benjamin J. Schladweiler, hereby certify that on July 2, 2018, I caused the foregoing *Defendant Minerva Surgical, Inc.'s Opposition to Plaintiffs' Motion In Limine No. 4 to Preclude Minerva From Arguing That the Patents-in-Suit Do Not Enable or Describe Unclaimed Features of the Accused Product* to be served via electronic mail upon the following counsel of record:

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